

## REMARKS

On page 5 of the official action dated March 29, 2005, the action is indicated to be final. This status is respectfully traversed as being premature on the first official action following successful Request for Continued Examination (RCE) containing amendments of the claims at issue.

It should be noted in the past record of this application that prosecution continued through official action dated February 26, 2004 and Amendments filed June 28, 2004 to the final official action dated November 1, 2004.

In response, Applicants filed timely RCE on December 16, 2004 with Amendments to claims at issue. Therefore, all claims now in the application are not drawn to the same invention claimed in the application previously, and by the latest official action, those claims have been rejected on new grounds (official action 3/29/2005, p. 4). Thus, by the Office Action summary sheet:

### **Status**

2b) ☒ This action is non-final

is the proper designation of the status of this application, and the designation of:

THIS ACTION IS MADE FINAL appearing on page 5 is submitted to be erroneous.

In addition, establishing this official action as FINAL is submitted not to be supported by the provisions of MPEP §706.07(a), cited by the Examiner. To the contrary, the provisions of this section of the MPEP are submitted to establish that

finality of this official action is premature. In addition, in the interest of fairness and progress toward refining newly-amended claims submitted herewith, it is submitted that this final action is premature.

Reconsideration and withdrawal of this final action are solicited.

Rejected claims 82, 84, 86, 100, 101, 103, 106-110 have been canceled.

Claims 81, 89-91, 111, 122-124, 126, 127 and 129 have been rejected under the judicially-created doctrine of obviousness- type double patenting as being unpatentable over corresponding claims of U.S. Patent No. 6,471,696.

Applicants are submitting herewith a Terminal Disclaimer with respect to U.S. Patent No. 6,471,696 to obviate this basis for rejection. It is therefore respectfully submitted that all pending claims in this application are now patentable to Applicants.

Claims 81, 89-91, 111, 122-124, 126, 127, and 129 have been rejected under 35 U.S.C. §103 as being unpatentable over Thome, et al.'021 in view of Eshel et al. '812. This rejection is respectfully traversed with respect to these claims as amended herein.

These claims as now amended variously recite "an ablation element operably disposed within the body portion to transmit electromagnetic ablation energy therethrough; and a shield disposed in fixed position relative to the ablation element within a portion of the body portion for directionally reflecting electromagnetic

ablation energy emitted through the outer surface”, and “a shield attached to said ablative element and disposed within said flexible body configured to reflect electromagnetic ablative energy to the surface of the heart through said contact surface and substantially prevent electromagnetic ablative energy from transmitting radially from said flexible body at locations other than said contact surface”, and “a flexible ablative element having a longitudinal axis and a shield affixed thereto aligned along the longitudinal axis to reflect electromagnetic energy for emitting electromagnetic ablative energy along said longitudinal axis predominantly in a direction through the contact surface, said flexible ablative element and shield being slidably disposed within said lumen of said flexible body out of contact with the surface of the heart”.

In addition, the claims which depend from the independent claims are submitted to be patentable to Applicants for that reason, and for such additional limitations as “the ablation element is flexible”, or “the flexible body portion holds the ablation element in a fixed angular position relative to the shield”, or “the shield for directionally reflecting the ablation energy is flexible”, or “the shield is disposed at the fixed angular position to inhibit ablation of biological tissue adjacent to the outer surface of the flexible body portion not aligned with the direction of the reflected electromagnetic ablation energy”, or “the outer surface of the ablation assembly is adapted to be manipulated to one of a plurality of contact positions and

to generally conform the portion of the outer surface oriented in said reflection direction to the biological tissue during tissue ablation”, or “at least the contact surface of the elongate flexible body is substantially transparent to the electromagnetic energy emitted by the ablative element”.

These aspects of the claimed invention are not disclosed or even suggested by the cited references considered either alone or in combination. Specifically, Thome et al. ‘021 is understood to rely upon cooling ducts and cooling balloon to diminish electromagnetic heating of biological tissue where not desired, and at best, is understood to disclose a thermometry unit or sensor disposed on one side of a microwave antenna.

Similarly, Eshel et al. ‘812 relies upon longitudinal cooling ducts for circulating fluid that diminishes the heating of biological tissue. A reflector disclosed in this reference is understood to reside in the outer body, rather than be affixed to an ablative element that slides within a lumen in the outer body. There is thus no composite structure, including elements in a configuration as claimed by Applicants, that is disclosed or suggested by either or both of the cited references considered in any combination. It is therefore respectfully submitted that the cited references combined as proposed by the Examiner fail to establish even a *prima facie* basis including all of Applicants’ claimed elements from which a proper determination of obviousness can be made. Claims 81, 89-91, 111, 122-124, 126,

127 and 129 as amended herein are therefore submitted to be patentable to Applicants.

Upon reconsideration of the impropriety of this first official action after an RCE as being a final action, for reasons as discussed in the above Remarks, then if the rejection of all pending claims is continued, it is respectfully requested that this amendment be entered in order to simplify and clarify the issues for appeal.

Respectfully submitted,  
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Dated: 6/29/05

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ATTACHMENT:

Terminal Disclaimer